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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,009	12/13/2000	Hiroaki Hamano	HAL 135	5643
7590 01/29/2004 David T. Cunningham, Esq. Hitachi America, Ltd. 50 Prospect Avenue Tarrytown, NY 10591			EXAMINER SALCE, JASON P	
			ART UNIT 2611	PAPER NUMBER 3
DATE MAILED: 01/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,009

Applicant(s)

HAMANO ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 117. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 7-9, 11-22, 24 and 26-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldstein (U.S. Patent No. 5,410,326).

Referring to claim 1, Goldstein discloses retrieving information comprising advertisement data from a device coupled to a server (see Column 3, Lines 29-34 for receiving data from a set-top box that receives data from a headend server). Also note Column 4, Lines 16-18 for displaying an advertisement to the remote control.

Goldstein also discloses activating said wireless terminal to an external stimulus (see Column 3, Lines 55-56 for a user activating the remote control).

Goldstein also discloses displaying said advertisement data on said terminal's display during at least a portion of said activation step (see Column 3, Lines 55-57 for displaying advertisements upon activation by the user of the remote control).

Referring to claim 2, Goldstein discloses that the displaying step is performed during the power up operation of said remote terminal (see again Column 3, Lines 55-57 for displaying during activation by the user).

Referring to claim 3, Goldstein discloses that the external stimulus is a power switch being engaged (see Column 12, Lines 54-58 for generating a power on/off signal).

Referring to claim 5, see Column 16, Lines 63-67 for receiving an external stimulus from a keyboard.

Referring to claim 7, see again Column 12, Lines 54-58 where Goldstein discloses powering up the remote control when the user handles the remote control (i.e. after the remote control had not been used previously (time out period)).

Referring to claim 8, Goldstein discloses a keyboard for sending a signal (to the remote control) in order to sound an audible alarm on the remote control so that a user can locate the remote control (see Column 16, Lines 62-67).

Referring to claim 9, Goldstein discloses that said advertising data is selected for at least one user of said remote terminal (see Column 3, Lines 45-51 for only displaying programs or advertisements based on what a single user has subscribed to).

Referring to claim 11, Goldstein discloses that the selected advertisement data is responsive to data indicative of said terminal viewer's personalized program menu (see Column 10, Lines 3-5).

Referring to claim 12, Goldstein discloses that the selected advertisement data is responsive to data indicative of said terminal viewer's program viewing history (see Column 27, Lines 19-27 for collecting a user's usage data).

Referring to claim 13, Goldstein discloses that the selected advertisement data is responsive to the terminal's usage functions enabled on said terminal (see again Column 27, Lines 19-27 for monitoring a user's usage activity).

Referring to claim 14, Goldstein discloses a second display 9 in Figure 1 and Column 8, Lines 51-61 for displaying the menus used to advertise what options are available to a user on the television 9.

Referring to claim 15, Goldstein discloses that the advertisement enables the interactive purchase of a product or service described in said advertising data (see Column 28, Lines 59-66 for placing an order using the remote control (also see Figure 22)).

Referring to claim 16, Goldstein discloses a device that receives advertising data from a server computer and transmits said data to a remote terminal (see Column 3, Lines 29-34 for receiving data from a set-top box that receives data from a headend server).

Goldstein also discloses at least one said remote terminal that displays said received advertising information concurrently (see Column 4, Lines 16-18 for displaying

an advertisement and Column 10, Lines 36-39 for provided linked menus, which would therefore present a main menu and submenus according to which buttons are actuated by a user (therefore concurrently displaying information)).

Goldstein also discloses that said advertising data is selected for at least one user of said remote terminal (see Column 3, Lines 45-51 for only displaying programs or advertisements based on what a single user has subscribed to).

Referring to claim 17, see television receiver 9 in Figure 1.

Referring to claim 18, see Column 16, Lines 33-37 for receiving data from a satellite.

Referring to claim 19, see rejection of claim 21.

Referring to claim 20, see rejection of claim 13.

Referring to claim 21, see rejection of claim 16. Also note that the additional limitation of "when said terminal's operating system is concurrently executing at least one program instruction" is met by Column 17, Lines 1-7, which is a microprocessor that runs the operating system, which controls all functions of the remote control, therefore if an advertisement is displayed, then the operating system is the means to control such a display function.

Referring to claim 22, see rejection of claim 2.

Referring to claim 24, see rejection of claim 7.

Referring to claims 26-29, see rejection of claims 10-13 and 15, respectively.

Referring to claim 30, see rejection of claim 16.

Referring to claims 31-32, see rejection of claims 9, 21 and 1, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Allport et al. (U.S. Patent No. 6,097,441).

Referring to claim 4, Goldstein discloses all of the limitations in claim 1, as well as displaying advertisements in response to an external stimulus (see rejection of claim 1), but fails to teach displaying the advertisements upon start up of a web browser. Allport discloses browsing the Internet on a remote control (see Column 7, Lines 38-53), and that such access can be accomplished by directly using buttons (see Column 7, Lines 55-58, and that one of the buttons is a power on/off switch (see Column 6, Line 28). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the remote control of Goldstein, using a remote controls ability to access the Internet, as taught by Allport, for the purpose of providing a system for using two or more cooperating but physically independent displays (remote control and TV) for achieving enhanced viewing and/or browsing of data on each display without affecting the viewing and/or browsing of data on the other displays (see Column 3, Lines 41-45 of Allport).

Referring to claim 6, Goldstein discloses all of the limitations in claim 4, but fails to teach that a computer mouse provides an external stimulus. Allport discloses that a

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keyboard or mouse can be used to navigate through an internet-enabled TV system on a remote control (see Column 7, Lines 49-55). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the remote control of Goldstein, to include a external stimulus to a remote control such as a computer mouse signal, as taught by Allport, for the purpose of aiding the user in navigating through internet related information (see Column 7, Lines 49-55 of Allport).

Referring to claim 23, see rejection of claim 4.

4. Claims 10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Darbee (U.S. Patent No. 6,130,726).

Referring to claim 10, Goldstein discloses all of the limitations in claim 9, but fails to teach that selected advertisement data is responsive to data indicative of said terminal viewer's Internet usage history. Darbee discloses collecting Internet usage data at a remote control (see Column 10, Lines 12-24). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the remote control taught by Goldstein, to collect Internet usage data, as taught by Darbee, for the purpose of providing the user with programming and/or advertising content that is tailored to the user's interests or demographic profile (see Column 2, Lines 38-42 of Darbee).

Referring to claim 25, see rejection of claim 10.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-

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1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

January 21, 2004


HAITRAN
PATENT EXAMINER